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Applicants: Bickford *et al.*

Examiner: Pyzocha, Michael J.

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REPLY BRIEF OF APPELLANT

This Reply Brief is in reply to the Examiner's Answer mailed December 4, 2006.

GROUND OF REJECTION 1

Claims 8, 9, 13, and 14 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Lindeman *et al.* (US 2003/0009698).

Appellants respectfully contend that Lindeman does not teach the following feature of claims 8, 9, 13, and 14:

“responsive to receiving the electronic mail, determining whether an authentication key is expected to be present in an open field of the electronic mail;
responsive to determining that the authentication key is expected to be present, determining whether the authentication key is present”.

The Examiner’s Answer, pages 10-11 argues that a CZID in Lindeman represents the claimed authentication key and that steps 702, 704 and 708 in FIG. 7 of Lindeman teach the preceding feature of claims 8, 9, 13, and 14. More specifically, the Examiner’s Answer, pages 10-11 argues:

“Lindeman discloses "responsive to receiving the electronic mail, determining whether an authentication key is expected to be present in an open field of the electronic mail" in figure 7 where a new message arrives at number 702 and in 704 a determination is made as to whether the a tunnel password is present. Where if the tunnel password is present, no CZID is expected to be present, while if the tunnel password is not present the CZID is expected (see also paragraphs 98-100). Furthermore the CZID is expected to be in the subject of the email (see paragraph 100). Next, Lindeman discloses "responsive to determining that the authentication key is expected to be present, determining whether the authentication key is present" in figure 7 numbers 704 and 708 where a check is

made if the CZID is present in the message after the determination is made as to whether the tunnel password is present. Therefore, the determination of whether the CZID is present in the open field is made in response to the determination that the CZID is expected to be present based on a lack of the tunnel password.... With respect to Appellant's argument that Lindeman does not have the two distinct tests, as discussed above, first Lindeman determines if the tunnel password is present (i.e. determining whether an authentication key is expected to be present) and in response to there not being a tunnel password determining if the CZID is located within the subject of the email (i.e. determining if the authentication key is present).”

In response to the preceding argument in the Examiner's Answer, Appellants acknowledge that step 708 in Lindeman, FIG. 7 teaches “determining whether the authentication key is present”, under the assumption that the CZID represents the claimed authentication key. However, there is no disclosure in Lindeman, FIG. 7 of determining whether the CZID is expected to be present. The Examiner's Answer relies on step 704 of Lindeman, FIG. 7. However, step 704 of Lindeman, FIG. 7 is a test of whether a tunnel password is present and is not a test of whether the CZID is expected to be present. The Examiner's Answer has not cited any language in Lindeman that explicitly expresses a test of whether the CZID is expected to be present, and no such language exists in Lindeman. Instead, the Examiner's Answer erroneously argues that step 704 inherently determines whether the CZID is expected to be present. Appellant next identifies errors in the preceding analysis in the Examiner's Answer and thus explains why step 704 does not inherently determine whether the CZID is expected to be present.

First, Appellants summarize the legal requirements of inherency in a rejection under 35 U.S.C. § 102(e). Under case law, the alleged inherency must **necessarily and inevitably** follow

from the teachings in the prior art and a high probability of occurrence is not sufficient demonstrating inherency. See MPEP 2112(IV) which recites: “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)... "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)” (bold emphasis added).

The Examiner’s Answer, page 11 argues that “where a new message arrives at number 702 and in 704 a determination is made as to whether the a tunnel password is present. Where if the tunnel password is present, no CZID is expected to be present ... (see also paragraphs 98-100).”

In response, Appellants assert that there is no disclosure in FIG. 7 or paragraphs 98-100 of Lindeman that if the tunnel password is present, no CZID is expected to be present. In fact, it

is clear from FIG. 7 of Lindeman that if step 704 determines that the tunnel password is present, then the presence or absence of the CZID in the message is irrelevant because step 706 is next executed, and step 706 leaves the message in the inbox folder. It is conceivable that the CZID may be left in the message as a default regardless of whether the tunnel password is present, in order to protect against accidentally not including the CZID when the tunnel password is not present. Therefore if the tunnel password is present, it does not necessarily and inevitably follow that no CZID is expected to be present. Consequently, Lindeman does not inherently teach that if the tunnel password is present, no CZID is expected to be present.

The Examiner's Answer, page 11 argues that "where a new message arrives at number 702 and in 704 a determination is made as to whether the a tunnel password is present. Where ... if the tunnel password is not present the CZID is expected (see also paragraphs 98-100)."

In response, Appellants assert that there is no disclosure in FIG. 7 or paragraphs 98-100 of Lindeman that if the tunnel password is not present, the CZID is expected to be present. In fact, it is clear from FIG. 7 of Lindeman that if step 704 determines that the tunnel password is not present then step 716 is executed next, and if step 716 determines the sender is a trusted sender then step 718 leaves the message in the inbox folder. Therefore, if step 704 determines that the tunnel password is not present, there is no resultant expectation that the CZID is present, since it is perfectly legitimate for the CZID not to be present if the sender is a trusted sender. Therefore, it does not necessarily and inevitably follow that if the tunnel password is not present, the CZID is expected to be present. Consequently, Lindeman does not inherently teach that if the tunnel password is not present, the CZID is expected to be present.

The Examiner's Answer, page 11 argues that "the CZID is expected to be in the subject

of the email (see paragraph 100)”

In response, Appellants cites Lindeman, Par. 100 as reciting: “Generally, determinations are made as to **whether** the message subject, body, and attachments display names include the strings "Please confirm:" and ".about.czid=abc"" (emphasis added), which does not teach that the CZID is expected to be in the subject of the email.

Based on the preceding arguments, Appellants respectfully contend that Lindeman does not anticipate claims 8, 9, 13, and 14.

In addition, Appellants respectfully contend that Lindeman does not teach the following feature of claims 8 and 14: “responsive to determining that the authentication key is not expected to be present, accepting the electronic mail”.

As explained *supra*, Lindeman does not explicitly or inherently teach determining that the authentication key is not expected to be present. Therefore, it is logically impossible for Lindeman to teach “responsive to determining that the authentication key is not expected to be present, accepting the electronic mail”.

Based on the preceding arguments, Appellants respectfully contend that Lindeman does not anticipate claims 8 and 14.

In addition, Appellants respectfully contend that Lindeman does not teach the following feature of claims 9, 13, and 14: “responsive to determining that the authentication key is not present, rejecting the electronic mail”.

Appellants assert that if step 708 in FIG. 7 of Lindeman determines that the CZID is not

present, it does not necessarily follow that the electronic mail is rejected. In fact, if step 708 determines that the CZID is not present then step 716 is executed next, and if step 716 determines the sender is a trusted sender then step 718 leaves the message is accepted (i.e., the message is left in the inbox folder).

Based on the preceding arguments, Appellants respectfully contend that Lindeman does not anticipate claims 9, 13, and 14.

In addition, Appellants respectfully contend that Lindeman does not teach the following feature of claim 14: “responsive to determining that the authentication key is associated with both the originator and the recipient, accepting the electronic mail”.

The Examiner’s Answer, pages 21-22 argues that “the CZID, as described in paragraph 31, is used to authenticate the source email address (i.e. originator) and destination email address (i.e. recipient). The determination step is performed in figure7, step 710 where the CZID is authenticated.... However, when an authenticated CZID is a user confirmation request the request is sent to the inbox and therefore the email is accepted (see figure 7, steps 712 and 714; paragraph 101).”

In response, Appellants assert that if step 710 in FIG. 7 of Lindeman authenticates both the source email address and the destination email address, it does not necessarily follow that the electronic mail is accepted. In fact, if step 710 determines that the CZID is not present, and if the next steps 712 and 720 determine that the message was not created for another spam filter user and that the message was generated by a third party mail server to indicate that the confirmation message could not be delivered, then step 722 moves the message to the bounced

folder.

Based on the preceding arguments, Appellants respectfully contend that Lindeman does not anticipate claim 14.

In addition, Appellants respectfully contend that Lindeman does not teach the following feature of claim 14: “responsive to determining that the authentication key is not associated with both the originator and the recipient, rejecting the electronic mail”.

The Examiner’s Answer, pages 21-22 argues that “the CZID, as described in paragraph 31, is used to authenticate the source email address (i.e. originator) and destination email address (i.e. recipient). The determination step is performed in figure7, step 710 where the CZID is authenticated.... However, when the authentication (i.e. the determination) is performed in step 710 of figure 7, no more processing can be performed on the message unless the CZID is authenticated because the further processing requires an authenticated CZID (see paragraphs 101-103). Since the message with an unauthenticated CZID cannot be accepted it is therefore rejected.”

In response, Appellants assert that if step 710 in FIG. 7 of Lindeman does not authenticate both the CZID, it does not necessarily follow that the electronic mail is rejected. Lindeman, Par. 101 discusses only the case of the CZID being authenticated in step 710 of FIG. 7 and is totally silent as to what happens if the CZID is not authenticated. Moreover, FIG. 7 does not depict what steps are performed if the CZID is not authenticated in step 710. Rejection of a message is indicated in FIG. 7 by steps stating explicitly that the message is to a folder that denotes non-acceptance of the message (e.g., a blacklisted folder (step 726) or a bounced folder

(step 722)). In contrast, there is no indication in FIG. 7 that the message is moved to a non-acceptance folder if step 710 does not authenticate the CZID. It is possible that if step 710 does not authenticate the CZID, the message will be further processed in some matter to determine whether to accept or reject the message based on other criteria.

In summary, Lindeman does not explicitly teach that the message is rejected if step 710 does not authenticate the CZID. Moreover, Lindeman does not inherently teach that the message is rejected if step 710 does not authenticate the CZID, because rejection of the message is not a necessary and inevitable consequence of step 710 not authenticating the CZID, as explained *supra*.

Based on the preceding arguments, Appellants respectfully contend that Lindeman does not anticipate claim 14.

GROUND OF REJECTION 2

Claims 3-5, 15, 17-18 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lindeman in view of Leeds (US 2002/0016824).

Claims 3-5 and 15

Appellants respectfully contend that claim 3 is not unpatentable over Lindeman in view of Leeds, because Lindeman in view of Leeds does not teach or suggest each and every feature of claim 3.

As a first example of why claim 3 is not unpatentable over Lindeman in view of Leeds, Appellants maintain that Lindeman in view of Leeds does not teach or suggest the feature: “storing an authentication key associated with an originator in a memory of the originator; reading the authentication key from the memory of the originator; preparing electronic mail for sending from the originator to a recipient, said preparing comprising including the authentication key, that had been read from the memory of the originator, in an open field of the electronic mail”.

The Examiner’s Answer, pages 10-11 argues that Leeds, Par. 37 teaches an authentication key associated with an originator, which Appellants do not disagree with. Appellants note that the authentication key in Leeds, Par. 37 is a secret unique identifier that is identified with the originator and is known to an e-mail handling system.

The Examiner’s Answer, pages 10-11 further argues: “Appellant also argues, with respect to claim 3, that the authentication key of Leeds is not stored or read from memory of the originator. However, for a user and email program to include the unique codes in a message, they

each must be stored in memory of the originator and thereafter read from the same memory.”

In response, Appellants notes that Leeds, Par. 37 teaches that the e-mail handling system sends this secret unique identifier and the “From” identifier to an authenticator, and the authenticator subsequently checks the secret unique identifier against a database of known junk e-mailers, and additionally checks the secret unique identifier for consistency against the “From” identifier. Therefore, both the e-mail handling system and the authenticator need to store the secret unique identifier in their respective memory. However, the originator has no need to store the secret unique identifier in the memory of the originator. Indeed, it is obvious to not store the secret unique identifier in the memory of the originator for security reasons, in order to protect the secret unique identifier from being accessed from the originator’s memory by an unauthorized party.

As a second example of why claim 3 is not unpatentable over Lindeman in view of Leeds, Appellants respectfully contend that the argument in the Examiner’s Answer for incorporating the alleged teaching of Leeds (as to storing the authentication key in the memory of the originator and reading the authentication key from the memory of the originator) is not persuasive, because in Leeds the authenticator tests the authentication key received from e-mail handling system without any need for the authentication key to be stored in the memory of the originator (as explained *supra* in relation to Leeds, Par. 37).

Moreover, it is not obvious to modify Lindeman to store the CZID (which is the authentication key in Lindeman) in the memory of the originator, because to do so would generate security concerns with regard to protecting the CZID from being accessed by an

unauthorized party from the memory of the originator.

Based on the preceding arguments, Appellants respectfully contend that claim 3 is not unpatentable over Lindeman in view of Leeds and is in condition for allowance. Since claims 4-5 and 15 depend from claim 3, Appellants contend that claims 4-5 and 15 are likewise in condition for allowance.

In addition with respect to claim 15, Appellants respectfully contend that Lindeman in view of Leeds does not teach or suggest the feature: “wherein the authentication key is dependent upon only an identity of the originator”.

The Examiner’s Answer, page 7 argues: “the modified Lindeman and Leeds system discloses the authentication key is dependent upon only an identity of the originator (see Leeds paragraphs 36 and 37) .”

In response, Appellants maintain that modifying Lindeman with the alleged teaching of Leeds with respect to the feature: “wherein the authentication key is dependent upon only an identity of the originator” would destroy the teaching of the CZID of Lindeman, because the CZID is essential to Lindeman’s invention. See Lindeman, Paragraph 29 (“ The CZID is **necessary** to authenticate the confirmation message” (emphasis added)).

Appellants note that Lindeman, Par. 31 recites: “The term "CZID" is an MD5 hash of the original sender address, the original destination address, and a secret string. A valid CZID is used to authenticate a message, the source email address, and the destination email address to Spam filter.”

The Examiner's Answer, page 24 states: "Creating a CZID dependent upon only the identity of the originator would not destroy the Lindeman reference because the authentication of the message and the recipient can be performed by other well-known cryptographic methods, such as digital signatures."

In response, Appellants assert that to decapitating the original destination address and the secret string from the CZID would change the CZID so drastically that the resulting CZID would no longer relate to Lindeman's invention. Appellants reiterate the necessity of the CZID being able to authenticate the confirmation message; i.e., see Lindeman, Paragraph 29 ("The CZID is **necessary** to authenticate the confirmation message" (emphasis added)).

Based on the preceding argument, Appellants respectfully contend that claim 15 is not unpatentable over Lindeman in view of Leeds.

Claims 17-18 and 20

Since claims 17, 18, and 20 depend respectively from claims 8, 9, and 13, which Appellants have argued *supra* to not be unpatentable over Lindeman under 35 U.S.C. §102(e), Appellants maintain that claims 17, 18, and 20 are likewise not unpatentable over Lindeman in view of Leeds under 35 U.S.C. §103(a).

In addition, with respect to claims 17, 18, and 20, Appellants respectfully contend that Lindeman in view of Leeds does not teach or suggest the feature: "wherein the authentication key is dependent upon only an identity of the originator".

The Examiner's Answer, page 7 argues: "the modified Lindeman and Leeds system discloses the authentication key is dependent upon only an identity of the originator (see Leeds

paragraphs 36 and 37) .”

In response, Appellants maintain that modifying Lindeman with the alleged teaching of Leads with respect to the feature: “wherein the authentication key is dependent upon only an identity of the originator” would destroy the teaching of the CZID of Lindeman, because the CZID is essential to Lindeman’s invention. See Lindeman, Paragraph 29 (“ The CZID is **necessary** to authenticate the confirmation message” (emphasis added)).

Appellants note that Lindeman, Par. 31 recites: “The term "CZID" is an MD5 hash of the original sender address, the original destination address, and a secret string. A valid CZID is used to authenticate a message, the source email address, and the destination email address to Spam filter.”

The Examiner’s Answer, page 25 states: “Creating a CZID dependent upon only the identity of the originator would not destroy the Lindeman reference because the authentication of the message and the recipient can be performed by other well-known cryptographic methods, such as digital signatures.”

In response, Appellants assert that to decapitating the original destination address and the secret string from the CZID would change the CZID so drastically that the resulting CZID would no longer relate to Lindeman’s invention. Appellants reiterate the necessity of the CZID being able to authenticate the confirmation message; i.e., see Lindeman, Paragraph 29 (“ The CZID is **necessary** to authenticate the confirmation message” (emphasis added)).

Based on the preceding argument, Appellants respectfully contend that claims 17, 18, and 20 are not unpatentable over Lindeman in view of Leeds.

GROUND OF REJECTION 3

Claims 6-7, 10-11, 16 and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the modified Lindeman and Leeds system and further in view of Liu *et al.* (US 6,760,752).

Claims 6-7 and 16

Appellants respectfully contend that claim 6 is not unpatentable over Lindeman and Leeds in further view of Liu, because Lindeman and Leeds in further view of Liu does not teach or suggest each and every feature of claim 6.

As a first example of why claim 6 is not unpatentable over Lindeman and Leeds in further view of Liu, Lindeman in view of Leeds does not teach or suggest the feature: “storing an authentication key in a memory of a recipient of the electronic mail”.

The Examiner’s Answer, page 26 argues: “The combination of Lindeman and Leeds teaches storing an authentication key in a memory of a recipient of the electronic mail (see Leeds paragraphs 36 and 37 where each user and email program contain the unique identification/authentication code).”

The Examiner’s Answer, pages 10-11 further argues that Leeds, Par. 37 teaches an authentication key associated with an originator, which Appellants do not disagree with. Appellants note that the authentication key in Leeds, Par. 37 is a secret unique identifier that is identified with the originator and is known to an e-mail handling system.

In response, Appellants notes that Leeds, Par. 37 teaches that the e-mail handling system

sends this secret unique identifier and the “From” identifier to an authenticator, and the authenticator subsequently checks the secret unique identifier against a database of known junk e-mailers as well as checked for consistency against the “From” identifier appearing in the email of the originator. Therefore, both the e-mail handling system and the authenticator need to store the secret unique identifier in their respective memory. However, the recipient has no need to store the secret unique identifier in the memory of the recipient. Indeed, it is obvious to not store the secret unique identifier in the memory of the recipient for security reasons, in order to protect the secret unique identifier from being accessed from the recipient’s memory by an unauthorized party. In fact, an argument can be made that the recipient is not authorized to have access to the secret unique identifier, since it is the authenticator and not the recipient that performs the process of authenticating the secret unique identifier. Therefore, based on the preceding analysis, Leeds not disclose storing the secret unique identifier in a memory of the recipient and it is furthermore not obvious to store the secret unique identifier in a memory of the recipient.

Moreover, it is not obvious to modify Lindeman to store the CZID (which is the authentication key in Lindeman) in the memory of the recipient, because to do so would generate security concerns with regard to protecting the CZID from being accessed by an unauthorized party from the memory of the recipient.

As a second example of why claim 6 is not unpatentable over Lindeman and Leeds in further view of Liu, Lindeman in view of Leeds does not teach or suggest the feature: “storing an authentication key in a memory of a recipient of the electronic mail **at an address that is dependent upon a source identifier that identifies an originator of the electronic mail**”

(emphasis added).

The Examiner's Answer, page 9 argues: "The modified Lindeman and Leeds system fails to disclose the address at which the key is stored is dependent upon a source identifier that identifies the originator. However, Liu et al teaches such addressing (see column 19 line 57 through column 20 line 14)."

The Examiner's Answer, page 26 further argues that "at the time of the invention one of ordinary skill in the art would have been motivated to use the storing method of Liu in order to provide a recovery database as disclosed by Liu column 19 line 57 through column 20 line 14. The benefits of using a recovery database are also put forth in Liu as supporting the recovery of the private key of the user in the event the private key is lost or the signature phrase is forgotten."

In response, Appellants maintain that the preceding argument by the Examiner's Answer for modifying Lindeman by the alleged addressing taught by Liu is not persuasive for the following reasons.

A first reason why the preceding argument by the Examiner's Answer for modifying Lindeman by the alleged addressing taught by Lindeman is not persuasive is that the Examiner's Answer suggested benefit for the modification ("supporting the recovery of the private key of the user in the event the private key is lost or the signature phrase is forgotten") is not disclosed in the Examiner's citation to Liu, col. 19, line 57 - col. 20, line 14. The Examiner's Answer does not indicate where such benefit is disclosed in Liu and provides no analysis to support the allegation that such benefit would result from the alleged addressing taught by Liu.

A second reason why the preceding argument by the Examiner's Answer for modifying Lindeman by the alleged addressing taught by Lindeman is not persuasive is that the Examiner's

Answer relies on use of a private key - public key pair of a public key infrastructure, which is not employed in Lindeman. Therefore, it is not obvious to modify Lindeman by the alleged addressing taught by Liu.

As a third example of why claim 6 is not unpatentable over Lindeman and Leeds in further view of Liu, Lindeman in view of Leeds does not teach or suggest the feature: “responsive to determining that the authentication key is not associated with the originator, rejecting the electronic mail”.

The Examiner’s Answer, page 8 alleges, without accompanying analysis, that Lindeman discloses the preceding feature of claim 6.

In response, Appellants assert that an analysis of Lindeman, FIG. 7 makes it clear that Lindeman does not disclose the preceding feature of claim 6. In particular, if step 710 in FIG. 7 of Lindeman does not authenticates the CZID (e.g., with respect to the address of the originator), it does not necessarily follow that the electronic mail is rejected. Lindeman, Par. 101 discusses only the case of the CZID being authenticated in step 710 of FIG. 7 and is totally silent as to what happens if the CZID is not authenticated. Moreover, FIG. 7 does not depict what steps are performed if the CZID is not authenticated in step 710. Rejection of a message is indicated in FIG. 7 by steps stating explicitly that the message is to a folder that denotes non-acceptance of the message (e.g., a blacklisted folder (step 726) or a bounced folder (step 722)). In contrast, there is no indication in FIG. 7 that the message is moved to a non-acceptance folder if step 710 does not authenticate the CZID. It is possible that if step 710 does not authenticate the CZID, the message will be further processed in some matter to determine whether to accept or reject the

message based on other criteria.

In summary, Lindeman does not explicitly teach that the message is rejected if step 710 does not authenticate the CZID (e.g., with respect to the address of the originator). Moreover, Lindeman does not inherently teach that the message is rejected if step 710 does not authenticate the CZID, because rejection of the message is not a necessary and inevitable consequence of step 710 not authenticating the CZID, as explained *supra*.

As a fourth example of why claim 6 is not unpatentable over Lindeman and Leeds in further view of Liu, Lindeman in view of Leeds does not teach or suggest the feature: “wherein said determining whether the authentication key is associated with the originator includes: reading the stored authentication key from the address at the memory of the recipient, and comparing the authentication key with the stored authentication key that had been read from the address at the memory of the recipient to determine whether the authentication key is associated with the originator”.

The Examiner’s Answer, page 27 alleges that the “comparing” preceding feature of claim 6 (i.e., “comparing the authentication key with the stored authentication key that had been read from the address at the memory of the recipient to determine whether the authentication key is associated with the originator”) is disclosed in Leeds, paragraphs 36 and 37.

In response, Appellants assert that the Examiner’s Answer has not provided any analysis to support the contention in the Examiner’s Answer that Leeds, paragraphs 36 and 37 discloses the “comparing” feature of claim 6, and Appellants cannot find a disclosure of said “comparing” feature of claim 6 in Leeds, paragraphs 36 and 37.

Furthermore, the Examiner's Answer has not provided any argument as to why it is allegedly obvious to modify Lindeman by the alleged "comparing" feature in Leeds, paragraphs 36 and 37.

Therefore, the Examiner's Answer has not established a *prima facie* case of obviousness in relation to claim 6.

Based on the preceding argument, Appellants respectfully contend that claim 6 is not unpatentable over Lindeman and Leeds in further view of Liu and is in condition for allowance. Since claims 7 and 16 depend from claim 3, Appellants contend that claims 7 and 16 are likewise in condition for allowance.

In addition with respect to claim 16, Appellants respectfully contend that Lindeman in view of Leeds does not teach or suggest the feature: "wherein the authentication key is dependent upon only an identity of the originator".

The Examiner's Answer, page 10 argues: "the modified Lindeman, Leeds and Liu system discloses the authentication key is dependent upon only an identity of the originator (see Leeds paragraphs 36 and 37) ."

In response, Appellants maintain that modifying Lindeman with the alleged teaching of Leeds with respect to the feature: "wherein the authentication key is dependent upon only an identity of the originator" would destroy the teaching of the CZID of Lindeman, because the CZID is essential to Landman's invention. See Landman, Paragraph 29 (" The CZID is **necessary** to authenticate the confirmation message" (emphasis added)).

Appellants note that Landman, Par. 31 recites: “The term "CZID" is an MD5 hash of the original sender address, the original destination address, and a secret string. A valid CZID is used to authenticate a message, the source email address, and the destination email address to Spam filter.”

The Examiner’s Answer, page 25 states: “Creating a CZID dependent upon only the identity of the originator would not destroy the Landman reference because the authentication of the message and the recipient can be performed by other well-known cryptographic methods, such as digital signatures.”

In response, Appellants assert that to decapitating the original destination address and the secret string from the CZID would change the CZID so drastically that the resulting CZID would no longer relate to Lindeman’s invention. Appellants reiterate the necessity of the CZID being able to authenticate the confirmation message; i.e., see Landman, Paragraph 29 (“ The CZID is **necessary** to authenticate the confirmation message” (emphasis added)).

Based on the preceding argument, Appellants respectfully contend that claim 16 is not unpatentable over Landman and Leeds in further view of Liu .

Claim 10

Since claim 10 depends from claim 9, which Appellants have argued *supra* to not be unpatentable over Landman under 35 U.S.C. §102(e), Appellants maintain that claim 10 is likewise not unpatentable over Landman and Leeds in further view of Liu under 35 U.S.C. §103(a).

In addition with respect to claim 10, Appellants respectfully contend that Landman in

view of Leeds does not teach or suggest the feature: “reading a flag from a memory of the recipient at an address that is dependent upon a source identifier that identifies the originator, wherein the flag indicates whether the electronic mail from the originator is expected to include the authentication key; and determining from the flag that had been read from the memory whether the authentication key is expected to be present in the open field of the electronic mail”.

The Examiner’s Answer, page 9 argues: “As per claim 10, the modified Landman, Leeds, and Liu et al system fails the memory has a flag for determining whether and authentication key is expected.... However, Official Notice is taken that at the time of the invention it would have been obvious to one of ordinary skill in the art to use a flag. Motivation to do so would have been that there are only two possible outcomes.”

In response, Appellants contend that the Examiner’s Answer has not even addressed the specific limitations included in the feature of: “reading a flag from a memory of the recipient at an address that is dependent upon a source identifier that identifies the originator, wherein the flag indicates whether the electronic mail from the originator is expected to include the authentication key; and determining from the flag that had been read from the memory whether the authentication key is expected to be present in the open field of the electronic mail”. Accordingly, the Examiner’s Answer has not established a *prima facie* case of obviousness in relation to claim 10.

The Examiner’s Answer, page 28 argues: “With respect to claim 10, Appellant argues that the Examiner has not addressed the specific limitations of claim 10. However, the limitation of claim 10 has been addressed with the use of Official Notice, which was relied upon to teach the use of a flag to indicate to indicate an authentication key is expected to be present, the

remaining limitations have been taught by Landman in view of Leeds and further in view of Liu. Since Appellant did not traverse Examiner's use of Official Notice on the subsequent action the Official Notice statement is taken to be admitted prior art because Appellant failed to traverse the Examiner's assertion of Official Notice (see MPEP 2144.03).”

In response, Appellants’ non-traversal of the Examiner's use of Official Notice as to the obviousness of using a flag to distinguish between two possible outcomes is not persuasive as to the preceding feature of claim 10, because the Examiner’s Answer has not provided an argument to support the claimed feature of where the flag is stored and how the flag is accessed (i.e., “reading a flag from a memory of the recipient at an address that is dependent upon a source identifier that identifies the originator”).

Based on the preceding argument, Appellants respectfully contend that claim 10 is not unpatentable over Landman and Leeds in further view of Liu.

Claim 11

Since claim 11 depends from claim 9, which Appellants have argued *supra* to not be unpatentable over Landman under 35 U.S.C. §102(e), Appellants maintain that claim 11 is likewise not unpatentable over Landman and Leeds in further view of Liu under 35 U.S.C. §103(a).

In addition with respect to claim 11, Appellants respectfully contend that Landman in view of Leeds does not teach or suggest the feature: “reading the stored authentication key from the address at the memory of the recipient, and comparing the authentication key with the stored authentication key that had been read from the address at the memory of the recipient to

determine whether the authentication key is associated with the originator”.

The Examiner’s Answer, pages 28-29 alleges that the “comparing” preceding feature of claim 6 (i.e., “comparing the authentication key with the stored authentication key that had been read from the address at the memory of the recipient to determine whether the authentication key is associated with the originator”) is disclosed in Leeds, paragraphs 36 and 37.

In response, Appellants assert that the Examiner’s Answer has not provided any analysis to support the contention in the Examiner’s Answer that Leeds, paragraphs 36 and 37 discloses the “comparing” feature of claim 11, and Appellants cannot find a disclosure of said “comparing” feature of claim 11 in Leeds, paragraphs 36 and 37.

Furthermore, the Examiner’s Answer has not provided any argument as to why it is allegedly obvious to modify Landman by the alleged “comparing” feature in Leeds, paragraphs 36 and 37.

Therefore, the Examiner’s Answer has not established a *prima facie* case of obviousness in relation to claim 11.

Claims 19

Since claim 19 depends from claim 9, which Appellants have argued *supra* to not be unpatentable over Landman under 35 U.S.C. §102(e), Appellants maintain that claim 19 is likewise not unpatentable over Landman and Leeds in further view of Liu under 35 U.S.C. §103(a).

In addition with respect to claim 19, Appellants respectfully contend that Landman in view of Leeds does not teach or suggest the feature: “wherein the authentication key is dependent

upon only an identity of the originator”.

The Examiner’s Answer, page 10 argues: “the modified Landman, Leeds and Liu system discloses the authentication key is dependent upon identity of the originator (see Leeds paragraphs 36 and 37).”

In response, Appellants maintain that modifying Landman with the alleged teaching of Leads with respect to the feature: “wherein the authentication key is dependent upon only an identity of the originator” would destroy the teaching of the CZID of Landman, because the CZID is essential to Lindeman’s invention. See Landman, Paragraph 29 (“The CZID is **necessary** to authenticate the confirmation message” (emphasis added)).

Appellants note that Landman, Par. 31 recites: “The term “CZID” is an MD5 hash of the original sender address, the original destination address, and a secret string. A valid CZID is used to authenticate a message, the source email address, and the destination email address to Spam filter.”

The Examiner’s Answer, pages 20-30 states: “Creating a CZID dependent upon only the identity of the originator would not destroy the Landman reference because the authentication of the message and the recipient can be performed by other well-known cryptographic methods, such as digital signatures.”

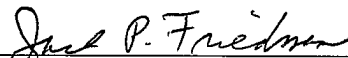
In response, Appellants assert that to decapitating the original destination address and the secret string from the CZID would change the CZID so drastically that the resulting CZID would no longer relate to Lindeman’s invention. Appellants reiterate the necessity of the CZID being able to authenticate the confirmation message; i.e., see Landman, Paragraph 29 (“The CZID is **necessary** to authenticate the confirmation message” (emphasis added)).

Based on the preceding argument, Appellants respectfully contend that claim 19 is not unpatentable over Landman and Leeds in further view of Liu .

SUMMARY

In summary, Appellants respectfully request reversal of the April 3, 2006 Office Action rejection of claims 3-11 and 13-20.

Respectfully submitted,



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